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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/413,012	10/05/1999	ALBERT K. CHIN	4496	1400

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EXAMINER

NGUYEN, VI X

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/413,012

Applicant(s)

CHIN, ALBERT K.

Examiner

Victor X Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 6-14 and 20-33 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 15, 16 and 17 are rejected under 35 U.S.C. 102 (b) as being anticipated by Ianniruberto et al (U.S. 5,226,890) or Green (U.S. 5,203,773).

Ianniruberto et al discloses a tissue dissector having a cannula (350), tip (310) and a solid dilating element (200) shown in fig. 4. Green discloses a tissue dissector including a cannula (25), pointed obturator (col. 5, lines 33-35), and a solid dilating element (10).

Claims 1, 2, 3, 5, 15-17 and 19 are rejected under 35 U.S.C. 102 (e) as being anticipated by Goodwin et al (U.S. 5,817,061).

Goodwin et al discloses a tissue dissector having a cannula (13), transparent tip (15, 18), and a solid dilating element (20).

Claims 16 and 18 are rejected under 35 U.S.C. 102 (b) as being anticipated by Haaga (U.S. 5,447,502).

Haaga discloses a tissue dissector having a cannula (17, fig. 1), pointed tip (19) and a foam dilating element (36, col. 7, lines 17-22).

Allowable Subject Matter

Claims 4, 6-14 and 20-33 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

None of the prior art of record disclose or suggest wherein a locking mechanism is at the tip on the distal end of the cannula. Furthermore, the dilating element includes a mating lock to mate with the locking mechanism for positioning the dilating element on the cannula.

Response to Arguments

2. Applicant's arguments filed 12/2/2002 have been fully considered but they are not persuasive. With respect to claims 1 and 15-17, according to the Applicant, since Ianniruberto et al. '890 or Green '773 discloses a solid dilating element (200, fig. 4 of Ianniruberto et al. '890 or 10, fig. 1 of Green '773) does not form a cavity in tissue in response to movement of a dilating element as recited in claims 1, 15-17. The examiner, respectfully, disagrees. The solid dilating element (200, fig. 4 of Ianniruberto et al. '890 or 10, fig. 1 of Green '773) is inherently capable of performing the same function as the applicant's device to form a cavity in tissue (col. 1 lines 45-67 of Ianniruberto et al. '890 and col. 5 lines 33-35 of Green '773). Therefore, the claimed invention is not patentable over Ianniruberto or Green's device.

3. With respect to claims 1-3, 5, 15-17 and 19, according to the Applicant, since Goodwin et al. '061 discloses a solid dilating element (20, figs 1 and 2) does not form a cavity in tissue in response to movement of a dilating element as recited in claims 1-3, 5, 15-17 and 19. The examiner, respectfully, disagrees. The solid dilating element (20, figs 1 and 2) is inherently capable of performing the same function as the applicant's device to form a cavity in tissue (col.2 lines 16-65). Therefore, the claimed invention is not patentable over Goodwin et al device.

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4. With respect to claims 16 and 18, according to the Applicant, since Haaga. '502 discloses a solid dilating element (36, figs3, 4 and 7-8) does not form a cavity in tissue in response to movement of a dilating element as recited in claims 16 and 18. The examiner, respectfully, disagrees. The solid dilating element (36, figs3, 4 and 7-8) is inherently capable of performing the same function as the applicant's device to form a cavity in tissue (col.3 lines 11-68). Therefore, the claimed invention is not patentable over Haaga's device.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone numbers for the


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organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Victor X Nguyen
Examiner
Art Unit 3731

vn vj
February 24, 2003


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700